REMARKS

Applicants have carefully reviewed and considered the contents of the Office Action mailed April 29, 2004. Reconsideration is respectfully requested of view of the comments set forth below.

The reissue declaration filed with this application was deemed defective because it allegedly fails to identify at least one error which is relied upon to support the reissue application. The present reissue application is a continuation of original reissue application (RE37,420). Under *In re Graff* 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997), multiple reissue patents are permitted even where the multiple reissue patents are not for "distinct and separate parts of the thing patented". Further, *In re* Graff at 876-877 stated that "the statute does not prohibit divisional or continuation reissue application, and **does not place stricter limitations** on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue are met"(emphasis added). Thus, continuation reissue applications are permitted and stricter rules do not apply (only those in 35 U.S.C. § 251).

Under 35 U.S.C. § 251, only a single error is necessary to support the reissue application. It is respectfully submitted that the original reissue declaration sets forth an error of the original patent that is corrected by the claims of the present continuation reissue application. The fact that the original reissue application also corrected that error should not limit the patentees' ability to file multiple reissue applications, as allowed by the U.S. Patent and Trademark rules. *Dethmers Mfg. Co., Inc. v. Automatic Equip. Mfg. Co.*, 272 F.3d 1365, 60 USPQ2d 1929 (Fed. Cir. 2001) addressed this issue in footnote 1 (page 1938). While the reissue declaration in *Dethmers* was subject to the older version of 37 CFR 1.175, reissue applications

filed on or after December 1, 1997 are subject to a more liberal view. The amended version of 37 CFR 1.175 requires a reissue application to state "at least one error". Moreover, *Dethmers* indicates as long as the errors previously stated in the original reissue declaration are being corrected and the reissue declaration "states that 'every ....error arose without any deceptive intention on the part of the applicant ", no additional error is needed. That is, *Dethmers* confirms that the reissue declaration need only to specify a single error.

The originally reissue declaration states that:

> For example, the sole independent claim of the patent, claim 1, recites a mobile telephone system which comprises a transmitting side apparatus in combination with a receiving side apparatus, although both the transmitting side apparatus and the receiving side apparatus are believed to be patentable in their own right. Furthermore, both of the claims of the patent 5,677,929 are apparatus claims and do not specifically provide for protection of the transmission and reception methods disclosed in the patent. (page 1 of original reissue declaration).

Claim 9 of the present reissue application is directed to a CDMA communication method while claim 10 is directed for a method for using CDMA communication system for transmitting information. Thus, claim 9 and 10 of the present reissue application clearly correct the lack of method claims to provide protection of the transmission and reception disclosed in U.S. Patent No. 5,677,929. Likewise, claim 11 is directed to a CDMA transmitter for transmitting information that corrects the first error mentioned in the original reissue declaration. Accordingly, it is respectfully submitted that the original reissue declaration need not be supplemented as the errors mentioned in the reissue application are being corrected by the present continuation reissue application.

Applicants submitted a Supplemental Declaration for Reissue Patent Application stating that errors corrected during the prosecution of the reissue application arose without any deceptive intention on the part of the Applicants on August 25, 2003. Thus, it is believed Applicants have complied with 35 U.S.C. § 251 and the requirements for a reissue application.

Claim 10 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. RE37,420 as explained in paragraph 4 of the Action. Submitted herewith for recordation in the U.S. Patent and Trademark Office is a Terminal Disclaimer to overcome the rejection of claim 10 under the judicially created doctrine of double patenting. Accordingly, withdrawal of the double patenting rejection is respectfully requested.

Claims 8-11 were rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. This rejection is respectfully traversed.

Under 35 U.S.C. § 251 a patentee can seek to enlarge the scope of the claims within two years of the grant of the original patent, if the error was made without deceptive intent. In this case, the original reissue application was filed on June 21, 1999 within two years of the patent issue date of October 14, 1997. As a continuation of the original reissue application, the present application is entitled to the filing date of the parent reissue application (June 21, 1999). Accordingly, the continuation application was filed within two years and the patentee can seek to enlarge the scope of the claims, as the error was made without deceptive intent. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat App & Int 2003) held that there is no per se rule of reissue recapture to prevent patentees from retreating from any patented claim limitation determined to have

secured allowance of the original patent. According to the decision in *Ex Parte Eggert*, a claim drafter may have erred in choosing amendatory language and that error is correctable under 35 U.S.C. § 251. The Board in *Ex Parte Eggert* held that a patentee is precluded from recapturing in reissue what he earlier conceded was unpatentable and abandoned or surrendered, whether by cancellation, amendment or argument. That is, a patentee cannot retreat to claim language that was abandoned (i.e. a previously presented and now amended claim) to overcome a prior art rejection.

It is the Action's position that the omitted patented claim limitation of "obtaining the spreading codes by multiplying the orthogonal codes with the second PN code having the same code as the first PN code but having different time phase thereby making the number of channels in the same cell larger than the numbers of the orthogonal spread codes" broadens the claim to subject matter surrendered in the patented application. This is because the claim limitation was "presented and repeatedly argued during the prosecution of the original patent." However, it is noted that the arguments in the original patent application that matured into the '929 patent are directed to an Automobile on-Board and/or portable telephone system. The present claims (and those of the reissue parent application) are directed to a CDMA communication system and method, as well as a method for use in a CDMA communication system and CDMA transmitter. Thus, the present reissue claims are directed to a system that is much narrower than the mobile telephone system in which the arguments were presented. That is, all of the claims of the continuation reissue application are directed to a code division multiple access (CDMA) system, method or transmitter, which is a specific type of communication system and not merely the

broad mobile telephone system of the U.S. Patent. The Manual of Patent Examining Procedure states that:

> If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the Examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. **If the narrowing limitation modifies the claim in such a matter that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture.** (page 1400-15 of the MPEP).

The present continuation reissue claims are directed to a different system (a more specific or narrower system) than the rejected automobile on-board and/or portable telephone system. While these claims were amended to a mobile telephone system, the patentee did not abandon or surrender these amended claims as he appealed the Examiner's rejection of the claims. The amended claims were then allowed. Thus, according to *Ex Parte Eggert*, the comparison is with the rejected claim limitations and not the issued claim. However, since the continuation reissue claims are directed to a much narrower communication system, it is respectfully submitted that the scope of the reissue claim does not result in recapture of the rejected claim scope. As noted on page 1727 of *Ex Parte Eggert*, the courts have recognized that the recapture rule may be avoided in circumstances where reissue claims are materially narrowed in respects other than those in which the reissue claims were broadened. Accordingly, it is believed that claims 8-11 are proper under 35 U.S.C. § 251.

Inasmuch as the reissue declaration objection and the double patenting rejection and the recapture rule rejection are the only rejections of the present continuation reissue application, it is respectfully submitted that the foregoing comments and accompanying Terminal Disclaimer

overcome the Action's non prior art rejections. Accordingly, it is believed that the instant application is in condition for allowance.

Should the Examiner believe that a conference with Applicants' representative would advance the prosecution of the application, the Examiner is encouraged to telephone the undersigned at the number listed below to arrange such a conference.

Respectfully submitted,

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